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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,083	07/03/2000	WOLF GEORG FORSSMANN	P65123US0	8457
136	7590	03/03/2004	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			SCHNIZER, HOLLY G	
			ART UNIT	PAPER NUMBER
			1653	

DATE MAILED: 03/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/508,083

Applicant(s)

FORSSMANN ET AL.

Examiner

Holly Schnizer

Art Unit

1653

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 13 November 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 78-94.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Christopher S. F. Low
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SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Holly Schnizer

Continuation of 3. Applicant's reply has overcome the following rejection(s): the rejections of Claims 62 and 66-67 under 35 U.S.C. 112, second paragraph. The prior art rejections of Claims 82-84 (previously claims 64-67) have been overcome since the new claims have been narrowed to a method of treating insulin-dependent diabetes mellitus. The rejection of former claims 63-77 (new claims 85-94) is overcome by applicant's argument..

Continuation of 5. does NOT place the application in condition for allowance because: the rejection under 35 U.S.C. 112, first paragraph is maintained because contrary to Applicants assertions, the new claims are drawn to methods of treating insulin-dependent diabetes and not insulin-independent diabetes. Thus, claims 82-84 are rejected under 35 U.S.C. 112, first paragraph, for the same reasons provided in the previous Office Action for claims 64-77. New claims 78-81 and 85-94 are identical to cancelled claims 60-62 and 68-77 which were rejected as anticipated over Danley et al. Danley et al. teach a compound having the formula of SEQ ID NO:1. Applicants argument that Danley et al. does not teach the amide modification at the C-terminus is not persuasive because Danley et al. teaches that derivatives of the peptides taught therein can be made including those wherein the C-terminal carboxyl group forms a carboxamide (p. 16, lines 48-53). Danley et al. also teaches how to make such carboxamide derivatives (p. 17, lines 28-30). The amendment limiting new Claims 82-84 to methods of treating insulin-dependent diabetes overcomes Danley et al. since Danley et al. only teaches using the peptides to treat insulin-independent diabetes (pp. 17-18). Habener also teaches a compound having the formula of SEQ ID NO:1. Applicants argument that Habener does not teach a C-terminal amide is not convincing since Habener claims amide derivatives of the peptides disclosed therein (see claim. 1, part B(4)). Thus, new claims 78-81 and 85-94 are also anticipated by Habener.